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THE TTAB

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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Peter M. Villari

Serial No. 76397979

Peter M. Villari Esq.

Inga Ervin, Trademark Examining Attorney, Law Office 111
(Craig Taylor, Managing Attorney).

Before Hairston, Chapman and Zervas, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Peter M. Villari to register the mark THE I.D.E.A. LAWYERS for "providing educational services, namely, assisting children with disabilities and/or developmental delays in obtaining appropriate private or public education under the state and Federal laws" in Class 41 and "legal services, namely,

providing assistance to parents with children with disabilities and/or developmental delays" in Class 42."¹

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's identified services, so resembles the previously registered mark THE IDEA ATTORNEYS for "legal services,"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

We affirm the refusal of registration only as to the Class 42 services.

Our determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *Federated Foods, Inc. v Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

¹ Application Serial No. 76397979, filed April 18, 2002, alleging a bona fide intention to use the mark in commerce. The word LAWYERS is disclaimed apart from the mark as shown.

² Registration No. 2,493,596 issued September 25, 2001. The word ATTORNEYS is disclaimed apart from the mark as shown.

Turning first to the services, we note that the examining attorney, in her brief on the case, has focused her arguments on the relationship between applicant's "legal services, namely providing assistance to parents with children with disabilities and/or developmental delays" and registrant's "legal services."³ The examining attorney argues that such services are legally identical to the "legal services" in the cited registration. Applicant, however, argues that the respective services are not similar because "[u]pon information, registrant *exclusively* provides intellectual property legal services in association with his or her asserted mark while Applicant *exclusively* provides legal services to assist children with disabilities and/or developmental delays to obtain an appropriate education in relation to his proposed mark." (emphasis in original) (Brief, p. 3). Further, applicant argues that the channels of trade and customers are different because its legal practice is based in Pennsylvania and registrant's legal practice appears to be based in Florida.

³ In view of the examining attorney's failure to discuss the relationship between applicant's educational services and registrant's legal services, we consider the refusal as to applicant's educational services to be withdrawn.

Applicant's argument is not persuasive. It has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the cited registration, rather than what the evidence shows the goods/and or services to be. See *Octocom Systems Inc. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.* 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Because registrant has not limited the legal services identified in the cited registration to any particular type, we must consider the identification to encompass legal services of all types, including applicant's specific type, i.e., legal services, namely providing assistance to parents with children with disabilities and/or developmental delays. Thus, as the examining attorney correctly observes, applicant's and registrant's respective services are legally identical.

Moreover, there are no restrictions or limitations in applicant's or registrant's respective recitations of services as to the geographic areas in which such services

are offered. In view thereof, the Board must consider that the parties' respective services could be offered and sold throughout the United States. See *Canadian Imperial Bank v. Wells Fargo Bank*, supra; *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Therefore, whatever actual differences there may be between applicant's services and the geographic area where such services are marketed and those of registrant, to the extent that these differences are not reflected in the respective identifications, they cannot be considered.⁴

This brings us to a consideration of the marks. The examining attorney argues that the marks are very similar because the word "idea" appears in each of the marks and the words "lawyers" and "attorneys" are interchangeable. Applicant, on the other hand, argues that the respective marks are different because "[t]he letters in Applicant's proposed mark are separated by periods thus indicating an acronym, whereas the letters used in registrant's mark are not separated by periods thus merely indicating the word

⁴ We point out that Trademark Rule 2.133(c) provides as follows: "Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use proceeding."

"idea." (Brief, p. 2). Further, applicant argues that the marks are also very different in connotation and commercial impression in that I.D.E.A. in applicant's mark references the "Individuals with Disabilities Education Act" and IDEA in registrant's mark connotes intellectual property.

In determining whether the marks are similar or dissimilar, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, each mark is comprised of the word THE, followed by I.D.E.A. or IDEA and the generic name of the services, i.e., LAWYERS or ATTORNEYS. I.D.E.A./IDEA is suggestive as applied to the respective services, and it therefore dominates the commercial impression created by each mark and is entitled to greater weight in our comparison of the marks. Notwithstanding applicant's inclusion of periods in I.D.E.A., the term is very similar in appearance to IDEA. Also, although some customers of applicant's legal services may understand I.D.E.A. to refer to the Individuals with Disabilities Education Act, there is no evidence that this would always be the case. On the contrary, it is plausible that a significant number of customers of applicant's services would view I.D.E.A. as a fanciful version of the word "idea." In other words, applicant's mark would likely be viewed and spoken as "The Idea Lawyers." Further, although the words LAWYERS and ATTORNEYS differ in sound and appearance, they are identical in terms of meaning.

We find, therefore, that when the marks THE I.D.E.A. LAWYERS and THE IDEA ATTORNEYS are viewed in their entirety, they are more similar than dissimilar in sound, appearance, connotation and commercial impression.

Under the circumstances, customers familiar with registrant's legal services offered under the mark THE IDEA ATTORNEYS would be likely to believe, upon encountering applicant's mark THE I.D.E.A. LAWYERS for legal services, namely providing assistance to parents with children with disabilities and/or developmental delays, that the services originated with or are somehow associated with or sponsored by the same source.

Decision: The refusal to register the mark for applicant's Class 42 services is affirmed. The application will proceed with respect to the Class 41 services.